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UNITED STATES DISTRICT COURT  
NORTHERN DISTRICT OF CALIFORNIA

RICOH COMPANY, LTD.,

Plaintiff,

vs.

AEROFLEX INCORPORATED, et al.,

Defendants.

**CASE NO. CV 03-4669-MJJ**

**DISCOVERY MOTION**

**RICOH'S NOTICE OF MOTION AND  
MOTION TO COMPEL PRODUCTION OF  
INITIAL DISCLOSURE DOCUMENTS  
FROM THE ASIC DEFENDANTS**

**Date: February 10, 2004**

**Time: 9:30 a.m.**

**Courtroom: 11**

**NOTICE OF MOTION AND RELIEF REQUESTED**

**TO ALL PARTIES AND THEIR ATTORNEYS OF RECORD:**

**PLEASE TAKE NOTICE** that on February 10, 2004, at 9:30 a.m. in Courtroom 11 of the above-referenced court Plaintiff Ricoh Company, Ltd. ("Ricoh"), will and hereby does move the Court for an order compelling Defendants Aeroflex et al., to produce the initial disclosure documents that defendants were required to identify pursuant to Rule 26(a) and that were requested by Ricoh.

Ricoh bases this motion upon the following Memorandum of Points and Authorities, the supporting declaration of Jonathan Weissglass and attached exhibits, all pleadings on file in this case, and such argument as may be heard by this Court.

**MEMORANDUM OF POINTS AND AUTHORITIES**

**INTRODUCTION**

Defendants have refused to produce their initial disclosure documents that should have been produced months ago. Even though defendants submitted their initial disclosures in May 2003, they have refused to produce any of the documents identified therein on the grounds that the documents are "irrelevant." On August 28, 2003, Judge Sleet of the District of Delaware held a two hour hearing in which he chastised defendants over their refusal to produce their initial disclosure documents. This Court should put an immediate end to defendants' interminable delays and order the immediate production of the requested documents.

**BACKGROUND**

This matter originated in the District of Delaware, when Ricoh sued a number of computer chip manufacturers for patent infringement. The patent-in-suit has claims directed to a computer aided design process for making an application specific integrated circuit (ASIC). The six defendants in the Delaware action are collectively referred to herein as "the ASIC defendants."

On May 30, 2003, all of the defendants filed a joint Initial Disclosure Statement (Ex. 1) identifying documents and tangible things as relevant under Fed. R. Civ. P. 26(a)(1). Categories of documents identified in defendants' Initial Disclosure included product design and development materials; marketing and promotional materials; sales and accounting statements; correspondence;

1 reports; presentations; publications; and electronic files. (*Id.* at p. 6.) None of the ASIC defendants  
2 produced any documents in conjunction with their Rule 26(a) disclosures, however.

3 After the ASIC defendants reaffirmed their refusal to produce documents identified in their  
4 initial disclosures, Ricoh served a single document request that was specifically targeted to their initial  
5 disclosure documents. Ricoh's Second Set of Document Requests was served on the defendants on July  
6 2, 2003. (Ex. 2.) The responses to that document request were substantially identical among all  
7 defendants. (Ex. 3-8.) Defendants have repeatedly refused to produce their initial disclosure  
8 documents, despite numerous meet and confer sessions. For example, on July 9, 2003 Ricoh's counsel  
9 sent a letter to defendants' counsel making arrangements to comply with Ricoh's Initial Disclosure  
10 requirements and suggesting defendants do the same. (Ex. 9, 7/9/03 E. Meilman letter to E. Moller).  
11 Defendants respond by claiming they are producing documents as indicated in their responses to Ricoh's  
12 discovery requests. (Ex. 10, 7/10/03 E. Moller letter to E. Meilman). In fact, the defendants simply  
13 refuse to produce their initial disclosure documents.

14 During a hearing before Judge Sleet on August 28, defendants conceded that their initial  
15 disclosures were "inartfully drafted." (Ex. 11, 8/28/03 Transcript). Judge Sleet called defendants'  
16 refusal to produce the initial disclosure documents "extraordinary." (*Id.* at 54.) After the hearing, Ricoh  
17 proposed that defendants submit a revised initial disclosure since defendants admitted their initial  
18 disclosure was "inartfully drafted" and vague. (Ex. 12, 8/28/03 letter from G. Hoffman to T. Corbin).  
19 Defendants have yet to submit a revised initial disclosure or respond to Ricoh's discovery request to  
20 produce the documents identified in defendants' initial disclosure.

## 21 ARGUMENT

### 22 DEFENDANTS SHOULD PRODUCE THEIR INITIAL DISCLOSURE DOCUMENTS 23 RESPONSIVE TO RICOH'S SECOND SET OF REQUESTS

#### 24 A. Defendants Should Be Compelled To Produce Documents Identified In Their Own 25 Initial Disclosure Statement

26 Defendants' joint Initial Disclosure Statement (Ex. 1) identified several categories of  
27 documents and tangible things as relevant under Fed. R. Civ. P. 26(a)(1). These relevant documents  
28 included product design and development materials; marketing and promotional materials; sales and

1 accounting statements; correspondence; reports; presentations; publications; and electronic files. (*Id.* at  
 2 p. 6.) By identifying these documents, defendants conceded their relevance, but nevertheless refused to  
 3 produce them, in violation of Fed. R. Civ. P. 37(a)(2)(A) (“if a party fails to make a disclosure required  
 4 by Rule 26(a), any other party may move to compel disclosure and for appropriate sanctions”).

# 5 **1. Document Request No. 1**

6 Ricoh’s Document Request No. 1 of its second request for documents (Ex. 2) states as  
 7 follows:

8 Produce all documents and tangible things identified in Section B (Items 1 through 8 of  
 9 Defendants’ Initial Disclosure Statement dated and served on or about May 30, 2003).

10 Defendant Aeroflex’s response (dated August 1, 2003) to Document Request No. 1 states as follows:

11 Defendant incorporates by reference its general and specific objections to Ricoh’s First Set of  
 12 Document Requests. Defendant further objects to this document request as unduly  
 13 burdensome and seeking discovery of information not reasonably calculated to lead to the  
 14 discovery of admissible evidence. Defendant further objects to this document request as  
 15 unduly burdensome and on the basis that it seeks detailed discovery regarding operations of  
 16 Defendant that has no relevance to Defendant’s ASIC Products or Methods. Defendant  
 17 designs and manufactures a large number of products and employs a large number of  
 18 personnel involved in production. Plaintiff has not identified any theory of infringement, or  
 19 which specific design step(s) or activities are relevant to its allegations of infringement, or  
 20 what activities Plaintiff considered during the reasonable pre-filing investigation, if any, that  
 21 it conducted prior to filing the present lawsuit. Defendant further objects to this document on  
 22 the grounds that it is redundant of Plaintiff’s other document requests. Subject to and  
 23 without waiving the foregoing general and specific objections, Defendant responds as  
 24 follows: Defendant will produce relevant, non-privileged documents in response to this  
 25 document request

26 (Ex. 3).<sup>1</sup>

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27 <sup>1</sup> Requests to all Defendants (Aeroflex Inc., AMI Semiconductor, Inc., Matrox Electronic Systems Ltd.,  
 28 Matrox Graphics Inc., Matrox International Corp. and Matrox Tech, Inc.) were identical (Ex. 4-8).  
 Responses of the Matrox defendants further objected to this document request. Matrox Tech, Matrox  
 Graphics Inc., and Matrox Int’l objected because “its production is performed at Defendant’s facilities in  
 Canada and is therefore not relevant to Plaintiff’s allegations of infringement. Design of ASICs or other  
 electronic systems and devices done in Canada could not constitute infringement, under any provision of  
 35 U.S.C. §271, of a United States patent. . . . In light of the foregoing objections, Defendant will not  
 produce documents in response to this document request.” Matrox Electronic Systems, Ltd responded  
 that “the requested documents are at the Defendant’s facilities in Canada, where the Defendant designs  
 the accused ASICs and other electronic systems and devices. Designing of a product in Canada cannot  
 cause infringement of a United States patent under any provision of 35 U.S.C. §271. . . . In light of the  
 foregoing objections, Defendant will not produce documents in response to this document request.”  
 (Ex. 7-8).

1 None of the ASIC defendants has produced any documents identified in their Initial Disclosures.

2 **2. The ASIC Defendants' Objections Are "Extraordinary"**

3 Judge Sleet found the defendants' failure to produce documents from their own Initial Disclosure  
4 to be "extraordinary." (Ex. 11, 8/28/03 Tr. at 54.) Defendants admitted in the August 28 hearing that  
5 their Initial Disclosure was "inartfully drafted" and "relatively generic." (Ex. 11, 8/28/03 Tr. at p. 54,  
6 line 22-23, p. 53, line 2.) Since by their own admission, defendants' Initial Disclosures were vague,  
7 Ricoh has requested that defendants submit a revised Initial Disclosure. (Ex. 12, 8/28/03 G. Hoffman  
8 letter). However, defendants have failed to either submit a revised Initial Disclosure or any documents  
9 falling into the categories described in their Initial Disclosure.

10 **3. The Matrox Defendants' Objections Are Meritless**

11 The Matrox defendants (Matrox Electronic Systems Ltd., Matrox Graphics Inc., Matrox  
12 International Corp., and Matrox Tech, Inc.) also disclosed eight categories of relevant documents on  
13 May 30, 2003, but now refuse to produce them. The only basis for this additional objection is that the  
14 Matrox defendants are based in Canada. This objection is without merit for four reasons. First, the  
15 Matrox defendants are subject to the jurisdiction of this Court, as this Court has already ruled. (*See* D.I.  
16 41 in CA 3:03-cv-02289, Order Denying Ricoh's Motion to Dismiss.) Second, Matrox Tech, Inc. has a  
17 plant and is doing work in Florida, as their counsel conceded. (Ex. 11, 8/28/03 Tr. at p. 67, lines 7-15).  
18 Third, the Matrox Defendants apparently believe they are entitled to summary judgment and so should  
19 not be excluded from any discovery obligation. There is no basis for the Matrox defendants to avoid  
20 responding to relevant discovery, especially since this Court has already directed them to resolve all  
21 such issues before the summary judgment motion is heard. Fourth, the Matrox entities have already  
22 agreed to provide other discovery, but have still refused to produce their initial disclosure documents.  
23 Therefore, the Canadian Matrox defendants are not removed from their responsibility of producing  
24 initial disclosure documents simply because they are located outside the United States.

**CONCLUSION**

Ricoh's motion to compel should be granted. The defendants should be required to produce all documents related to their Initial Disclosure Statement and requested by Ricoh's Second Request for Documents.

Dated: January 6, 2004

Respectfully submitted,

Ricoh Company, Ltd.

By: /s/ Ken Brothers

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